

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

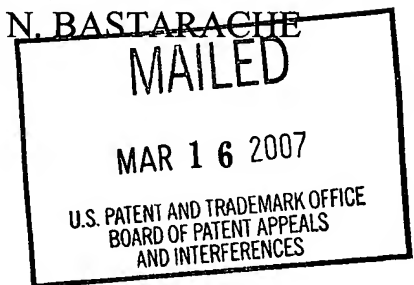
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*Ex parte* DENNIS M. HILTON, MICHAEL D. MORGAN, ROBERT PAUL,  
KARL D. TAUB, ROBERT S. YOUNG, and RICKY N. BASTARACHE

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Application 10/674,745  
Technology Center 1700

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This Image File Wrapper (IFW) application was electronically received at the Board of Patent Appeals and Interferences on November 15, 2006. A review has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below:

*APPEAL BRIEF*

Appellants filed an Appeal Brief which was received by the USPTO on May 5, 2006. The following section lacks required content:

*Status of Claims*

The content provided under the heading “**III. STATUS OF CLAIMS,**” is not commensurate in scope with 37 C.F.R. § 41.37(c)(1)(iii) because the content does not clearly set forth the claims that are on appeal. Correction is required.

*EXAMINER’S ANSWER*

The Examiner’s Answer (mailed July 28, 2006), is not in compliance with the *Manual Examining Procedure (MPEP)* §§ 1207.02 and 1207.03. Amended claim 13 that was not included in the final Office action under 35 U.S.C. § 103(a) (mailed July 8, 2005), is *now* listed on page 4 of the Examiner’s Answer as being rejected to under § 103(a). This is improper because it constitutes a new ground of rejection. The Examiner needs to either reopen prosecution to address the new ground of rejection with respect to amended claim 13, or submit a corrected Examiner’s Answer to address newly added claim 13 to the rejection under 35 U.S.C. § 103(a) .

Accordingly, it is

*ORDERED* that the application is returned to the Examiner:

- 1) to instruct Appellants to provide a Supplemental Appeal Brief which fully complies with 37 C.F.R. § 41.37(c)(1)(iii);
- 2) to have said Supplemental Appeal Brief made a part of the IFW Official record; and

Application 10/674,745

3) to follow guidelines pursuant with the *MPEP* and the above instruction pertaining to claim 13; and

4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES



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PJN:hh

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